REMARKS

Claims 16-26 were previously pending in the present application. By this amendment, claims 16 and 22 have been amended as set forth above and in Appendix A. Claims 18 and 19 have been cancelled without prejudice or disclaimer to the subject matter therein. The Applicants note that amended claim 16 has been amended to include all the limitations of claim 19. New claim 27 has been added. It is respectfully submitted that the pending claims define allowable subject matter.

As a side matter, the Applicants wish to thank the Examiner for making the extra effort to particularly point out the basis for the Examiner's rejections. In particular, the Applicants appreciate the Examiner's helpful insights regarding the application during two telephonic discussions with the undersigned on December 9 and 10, 2002. The Applicants thank the Examiner for the Examiner's high-quality work.

The Applicants have enclosed the requested IDS referred to in the preliminary amendment. The Applicants apologize for not submitting the enclosed Information Disclosure Statement (IDS) sooner. The assignee of the present application has been involved in litigation that has uncovered various references, which are included in the IDS. Additionally, as the undersigned mentioned during one of the telephonic discussion with the Examiner, the current application is part of a patent family. Various references have been cited during prosecution of related applications and patents with the patent family. All of these references are included within the enclosed IDS. The Applicants are confident that the claims of the present application are patentable in view of the references cited in the IDS. The Examiner is invited to contact the undersigned to discuss any concerns with these references.

Claims 16-26 were rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 6,397,189.

Claims 16-18, 20, 22-23 and 25-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,497,502 ("Castille") in view of United States Patent No. 4,949,187 ("Cohen"). Claims 21 and 24 were rejected under 35 U.S.C. 103(a) as

being unpatentable over Castille in view of Cohen in view of Official Notice. The Applicants respectfully traverse these rejections.

Claim 17 was objected to because the first occurrence of the word "song" is confusing. Claim 17 has been amended to overcome this objection.

Claim 19 was objected to as being dependent upon a rejected base claim, but was said to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcoming the 101 rejection. The Examiner noted that "Castille does not disclose a user attract mode wherein song associated images are shown."

The Applicants now turn to the Section 101 rejection of claims 16-26. Claims 16-26 were rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of United States Patent No. 6,397,189 ("the '189 patent"). The '189 lists the same inventors as the current application. Further, the '189 patent and the current application are both assigned to the same entity.

As per a phone interview on December 9, 2002, the Applicants informed Examiner Dixon that the published claims of the '189 patent do not accurately reflect the actual scope of the claims. When the '189 patent was published, various limitations added during prosecution were not entered. A Certificate of Correction is contemporaneously being filed for the '189 patent to correct the omission of those claim limitations. Moreover, the Applicants have amended the claims of the current application (most notably by deleting limitations) so that the current claims are no longer coextensive in scope with the published, although erroneous, claims of the '189 patent. In an effort to expedite the prosecution of the current application, the Applicants have enclosed a Terminal Disclaimer to obviate any non-statutory double patenting issues that may arise in relation to the '189 patent.

The Applicants now turn to the rejection of claims 16-18, 20, 22-23 and 25-26 under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,497,502 ("Castille") in view of United States Patent No. 4,949,187 ("Cohen"). Initially, the Applicants reiterate that claim 16 has been amended to include the limitations of claim 19, which the Examiner

found to be drawn to allowable subject matter. Hence, claim 16, and the claims that depend therefrom (claims 17, 20 and 21)[1], should now be in condition for allowance.

Castille, in the Abstract, discloses the following:

> [A] method and apparatus for transmitting information recorded on a collection of digital disks from a central server via a high data rate digital telecommunications network to subscribers connected to the network.

In Castille, a server center 1 is connected to a high data rate telecommunications network 2 capable of conveying digital information at a high rate. A plurality of subscriber serving stations 3 are connected to the telecommunications network 2. The server center 1 includes a programmable controller 6 controlled by a computer 4, which is connected to the network by a communications interface circuit 5.

In column 10, lines 20-22, Castille discloses that "the disk controller 6 controls the various electromechanical equipments (sic) of the central server in a manner analogous to the disk handler of a jukebox." However, Castille does not teach, nor suggest, that the subscriber serving stations are, or include, jukeboxes. In fact, Castille does not teach, nor suggest a method or apparatus that includes computer jukeboxes.

Cohen, in the Abstract, discloses the following:

> A video communications system is provided that makes it possible for home viewer to download a movie in digital format from a large archive library, store the digital movie file locally, and view the movie at any convenient time.

Similar to Castille, however, Cohen does not teach, nor suggest a computer jukebox. Thus, the combination of Castille and Cohen does not teach, nor suggest a computer jukebox.

Claim 16 of the present application is directed toward "an improved computer jukebox," while claim 22 recites, in part, "An improved computer jukebox network comprising: a plurality of computer jukeboxes." Neither Castille, nor Cohen, individually, or in combination with each other, teach or suggest a computer jukebox. Because Castille and Cohen do not teach, nor suggest a computer jukebox, Castille and

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[1] As mentioned above, claims 18 and 19 have been cancelled without prejudice or disclaimer to the subject matter therein.

Cohen do not render Claims 16 and 22 obvious. Thus, the claims of the present application should be in condition for allowance.
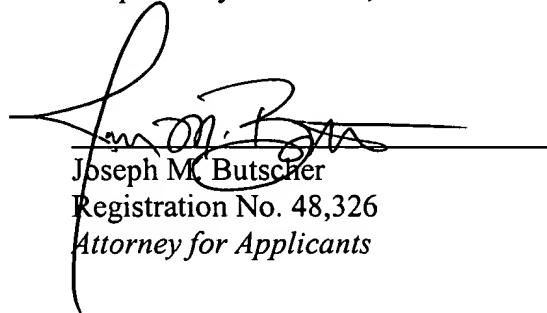
New claim 27 has been added in light of these arguments.[2] Neither Castille, nor Cohen, alone or in combination with each other, teach or suggest all of the elements and limitations of new claim 27.

CONCLUSION

In light of the above, the Applicants request reconsideration of the application and look forward to working with the Examiner to resolve any remaining issues in the application.

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the applicants. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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[2] The Applicants note that claim 16 was rewritten to include the limitations of claim 19, which the Examiner noted included allowable subject matter. However, the Applicants do not intend for this to be an admission that the original claim 16 was unpatentable over Castille in view of Cohen.

APPENDIX A

IN THE CLAIMS

16. (Amended/Marked-Up)   An improved computer jukebox for playing songs selected by users of the computer jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, where the library of songs stored in the computer jukebox is capable of being updated upon the receipt of compressed digital song data, which represents at least one song, [and] upon the receipt of song identity data, which represents the identity of each such song and upon receipt of compressed pictorial graphics which represent song associated pictorial graphics, and which are associated with the song identity data, the computer jukebox comprising:

a communication interface for receiving the compressed digital song data and the song identity data;

a data storage unit for storing the received compressed digital song data, [and] the received song identity data for each of the songs stored, and the compressed pictorial graphics, received by the communication interface;

a display for showing, to prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the data storage unit and that is based on song identity data;

selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys;

at least one audio speaker;

a processor; [connected to] a memory connected with the processor, the memory including a decompression algorithm for decompressing compressed digital song data, instructions causing the processor, when no song is playing on the computer jukebox, to generate a user attract mode wherein song associated graphic images are shown on the display;

[a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker;] and

[wherein] the memory further [includes] including instructions for:

causing the processor, in response to the signal output, to access and process compressed digital song data retrieved from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys;

causing the processor to decompress the accessed compressed digital song data [and send the decompressed digital song data to the digital to analog converter] so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor [and the digital to analog converter]; and

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox.

17. (Amended/Marked-Up) The computer jukebox of claim 16, wherein the memory further comprises instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting [song] the song usage data under the control of the processor.

22 (Amended/Marked-Up). An improved computer jukebox network comprising: a plurality of computer jukeboxes where each computer jukebox is capable of playing songs selected by users of the computer jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox and where the library of songs is capable of being updated upon the receipt of compressed digital song data, which represents at least one song, and upon the receipt of song identity data which represents the identity of each such song; and a management station for updating the library of songs in each of the plurality of computer jukeboxes;

with each computer jukebox comprising:

a communication interface for receiving the compressed digital song data and the song identity data;

a data storage unit for storing the received compressed digital song data and the received song identity data for each of the songs stored;

a display for showing, to prospective user of the computer jukebox, information based on song identity data for identifying the songs for which digital song data is stored in the data storage unit;

[selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys;

at least one audio speaker;]

a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data;

[a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker;] and

wherein the memory further includes instructions for:

causing the processor, in response to the signal output, to access and process compressed digital song data retrieved from the data storage unit so that the accessed compressed digital song data corresponds to the song selected [by the selection keys];

causing the processor to decompress the accessed compressed digital song data [and send the decompressed digital song data to the digital to analog converter] so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed digital song data being decompressed and converted by the processor [and the digital to analog converter]; and

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox; and

wherein the management station comprises:

a communication interface including a receiver and a transmitter; and

a management station processor connected to a management station memory, the management station memory including instructions for:

causing the management station processor to store digital song data, representing a set of songs, and song identity data, representing the identity of each song in the set of songs in a management station data storage unit;

causing the management station processor to compress digital song data stored in the management station data storage unit;

causing the management station processor to compress and transmit a subset of the digital song data and transmit corresponding song identity data to at least one selected computer jukebox to update the library of songs in the computer jukebox.